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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,117	01/29/2004	Tarri E. Furlong	OIC0142C1US	7173
60975 7590 09/21/2007 CAMPBELL STEPHENSON LLP 11401 CENTURY OAKS TERRACE BLDG. H, SUITE 250 AUSTIN, TX 78758			EXAMINER HEWITT II, CALVIN L	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 09/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/769,117

Applicant(s)

FURLONG ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-6 have been examined.

Response to Amendments/Arguments

2. Applicant is of the opinion that the prior art of does not read on Applicant's claims as the Vance et al. system is not "fully automated". Specifically, Applicant asserts that a distinguishing characteristic of the claimed method, for example, is that the prior art fails to disclose, "in response to each activation of the expense report creation button, without any user input to the process of creating an expense report..." (emphasis added). However, it has been held it is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result (*In re Venner*, 120 USPQ 192 (CCPA 1958); *In re Rundell*, 9 USPQ 220). Therefore, it is at least obvious to one of ordinary skill to fully automate the expense reporting function of Vance et al. (figures 10 and 16B-K). Nonetheless, Vance et al. clearly teach that expense reports can be generated semi-automatically or can be autofilled from a corporate database (column/line 12/65-13/20). Regarding "unreported" items, Vance et al. disclose a policy database for indicating (i.e. "exceptions") to a user,

actions which violate a corporate policy (figures 16D and K; column 13, lines 25-36), therefore the prior art at least suggests to one of ordinary skill deleting an expense item, such as "car insurance (figure 16D) or miscellaneous item (old and well known), using a "remove row" (figure 16D) that would prevent a submitted expense report from being authorized (column 9, lines 23-29; column 13, lines 34-36). Again, it would have been obvious to one of ordinary skill to further automate any part of this process in order to allow a traveler to more efficiently complete and submit an expense report (*In re Venner*, 120 USPQ 192 (CCPA 1958); *In re Rundell*, 9 USPQ 220).

Applicant's claims 1, 3 and 5 are broad enough to read on an expense report *without any* unreported items, limitations directed to creating a new expense report and the like performed in response to unreported items do not further limit the claims (MPEP §2106 II C; *In re Johnston*, 77 USPQ2d 1788 (CAFC 2006)).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1, 3 and 5 recite an "unreported flag". Applicant's Specification, however, merely discloses an "expense flag" (page 12, lines 1-3) and non-expensable items (e.g. page 14, lines 1-9).

Claims 2, 4, and 6 are also rejected as claim depends from either claim 1, 3 or 5.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 3 and 5 recites the term "unreported". Applicant's Specification, however, only discloses an "expense flag" (page 12, lines 1-3) and non-expensable items (e.g. page 14, lines 1-9), therefore, it is not clear to one of ordinary skill what Applicant intends by the term (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

Claims 2, 4, and 6 are also rejected as claim depends from either claim 1, 3 or 5.

Claims 1, 3, and 5 recite "without any user input subsequent to the activation of the second button", however it is not clear to one of ordinary skill what Applicant intends by this limitation, as Applicant has not limited the "user input". For example, turning on a computer, checking e-mail, opening an application or a file, and accessing different features of an application (e.g. "print", selecting a font) are all examples of user input, which take place, or can take place while performing a data processing action (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

Claims 2, 4, and 6 are also rejected as claim depends from either claim 1, 3 or 5.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vance et al., U.S. Patent No. 6,442,536.

As per claims 1-6, Vance et al. teach system for generating an expense report comprising:

- displaying controls with buttons (figures 16B-K)
- creating an activity item and activity type (figures 16B-C)
- creating an expense item (figures 16C-G)
- automatically consulting a policy database and setting an "unreported" flag (figure 16D and K)
- updating the expense report to bring it within policy guidelines (figure 16D; column 9, lines 20-30) and submitting the report (column 13, lines 25-36)
- automatically associating an expense item with its corresponding activity item by date (figure 16B; column/line 12/65-13/20)

Regarding "unreported" items, Vance et al. disclose a policy database for indicating (i.e. "exceptions") to a user, actions which violate a corporate policy (figures 16D and K; column 13, lines 25-36), therefore the prior art at least suggests to one of ordinary skill deleting an expense item, such as "car insurance (figure 16D) or miscellaneous item (old and well known), using a "remove row" (figure 16D) that would prevent a submitted expense report from being authorized (column 9, lines 23-29; column 13, lines 34-36). Also, it would have been obvious to one of ordinary skill to automate any part of the expense

report generation process of Vance et al. in order to allow a traveler to more efficiently complete and submit an expense report (*In re Venner*, 120 USPQ 192 (CCPA 1958); *In re Rundell*, 9 USPQ 220).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

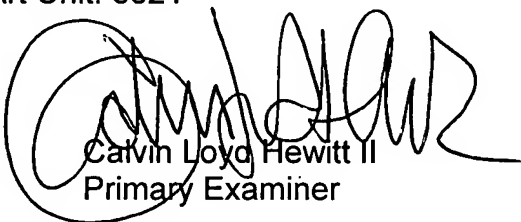
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Calvin Loyo Hewitt II
Primary Examiner

September 10, 2007